

Attorney's Docket No.: 02103-415001  
Client's Ref. No.: AABOSS39

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Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001

Art Unit : 2832  
Examiner : Tuyen Nguyen

Title : Transformer Shielding

Hon. Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attached to this facsimile communication cover sheet is Petition to Withdraw Requirement for Restriction, faxed this 26th day of July, 2004, to the United States Patent and Trademark Office.

Respectfully submitted,  
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Date: July 26, 2004

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Title : TRANSFORMER SHIELDING

Art Unit : 2832  
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PETITION TO WITHDRAW REQUIREMENT FOR RESTRICTION

Responsive to the Office Action dated July 1, 2004, and under the provisions of 37 C.F.R. §1.144, Application Owner respectfully petitions the Director to review and withdraw the requirement for restriction.

In an Office Action dated February 25, 2003, the Examiner made the following Election/Restriction:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to a transformer, classified in class 336, subclass 180.
  - II. Claims 14-25, drawn to a power supply, classified in class 323, subclass 355.
  - III. Claims 26-37, drawn to an electronic device, classified in class 330, subclass 276.
  - IV. Claims 38-48, drawn to a shielding device, classified in class 336, subclass 84R.
  - V. Claims 49-54, drawn to an electrical apparatus, classified in class 174, subclass 35R.
2. The inventions are distinct, each from the other because of the following reasons:

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Charles Hicken

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Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 2 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

Inventions [I-IV] and [V] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention [I] has separate utility such as a transformer not using the power supply of [II] or used in the electronic device of [III] or using the shielding device of [IV] or electrical apparatus of [V], invention [II] has separate utility such as a power supply not using the transformer of [I] or used in the electronic device of [III] or using the shielding device of [IV] or electrical apparatus of [V], invention [III] has separate utility such as an electronic device not using the transformer of [I] or the power supply of [II] or used in the electronic device of [III] or using the shielding device of [IV] or electrical apparatus of [V], invention [IV] has separate utility such as a shielding device not use in the transformer of [I] or in the power supply of [II] or used in the electronic device of [III] or electrical apparatus of [V] and invention [V] has separate utility such as an electrical apparatus not using the transformer of [I] or the power supply of [II] or used in the electronic device of [III] or using the shielding device of [IV]. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Pp. 2-3.

In a response sent March 25, 2003, Application Owner traversed the requirement for restriction and provisionally elected claims 38-48 in Group IV for further prosecution in the application should the requirement be made final. Application Owner said:

35 U.S.C. §121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." M.P.E.P. headed 802.01, "Meaning of 'Independent', 'Distinct' reads as follows:

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 3 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

### INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

### DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

The Examiner has not shown that the claims in each group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

The Examiner has made no showing whatsoever that the inventions are INDEPENDENT.

M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

And M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION."

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the transformer must be searched in connection with examining the claims in the other groups.

The Court of Customs and Patent Appeals has also recognized that "independent and distinct" means "independent and distinct." *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334, 336 (C.C.P.A. 1978).

In a decision dated June 23, 1977, on a petition filed June 13, 1977, Group 1210 Director Alfred L. Leavitt in granting the petition to withdraw the requirement for restriction said:

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 4 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

Current Office policy is not to require restriction between related inventions when no substantial burden is involved in the examination of all claims in a single application.

And in a decision dated 3 December 1993 on a petition filed March 12, 1993, Group 1100 Deputy Director John Doyle said:

Restriction was required between (I)method for epitaxial deposition and (II)epitaxially deposited product (Paper No. 4). However, the examiner failed to present any convincing basis for the holding that the inventions as above grouped are distinct. The claimed inventions must be independent or distinct, and the examiner "must provide reasons and/or examples to support conclusions . . .". Further, the field of search for the alleged distinct inventions is seen to be coextensive, hence, no serious burden is seen to be incurred by examination of all pending claims. MPEP 803 under "Criteria For Restriction Between Patentably Distinct Inventions".

The Petition is GRANTED.

That claims 38-48 are directed to a shielding device and the other claims include the shielding device of Group IV has nothing to do with the requirements of establishing that the groups are both independent and distinct and that search and examination of the entire application cannot be made without serious burden.

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the claimed shielding device are likely to disclose subject matter related to the remaining claims, which must be searched in connection with examining claims 38-48. Accordingly, it is respectfully requested that the requirement for restriction be withdrawn. If the requirement for restriction is repeated, the Examiner is respectfully requested to rule that the claims in each group ARE PATENTABLE (novel and unobvious) OVER EACH OTHER and explain why all the claims cannot be examined without serious burden.

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 5 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

In an Office Action dated April 23, 2003, the Examiner said:

1. Applicant's election with traverse of claims 38-48 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that searching and examining the entire application can be made without serious burden because prior art related to the shielding device. This is not found persuasive because the transformer, power supply, the electronic device and the electrical device would require searches in other areas.

The requirement is still deemed proper and is therefore made FINAL.

In a response sent October 23, 2003, Application Owner said:

Claims 1-45 and 47-54 are presented for reconsideration without amendment in light of the following remarks and authorities. Claim 46 and any dependent claims have been amended to overcome a minor informality without narrowing the claims. Such amendment to claims is only for the purpose of expediting the prosecution of this application and is not to be construed as an abandonment of any of the novel concepts disclosed therein.

1. The requirement for restriction is again respectfully traversed at least for the reasons set forth in the response filed April 1, 2003.

In the Office Action dated April 23, 2003, the Examiner did not deal with the reasoning and authorities set forth on pages 1 and 2 of the response which require that the Examiner make a showing that the inventions be independent and distinct. We said, "Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." The Examiner is again respectfully requested to comply with this request should the requirement for restriction be again maintained. P. 11.

In an Office Action dated July 1, 2004, the Examiner said:

This application is in condition for allowance except for the presence of claims 1-37 and 49-54 to an invention non-elected with traverse in the reply filed on 04/01/2003. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter. P. 2

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 6 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

Application Owner respectfully petitions the Director to order withdrawal of the requirement for restriction for the reasons set forth above and for additional reasons set forth below.

The Examiner has stated:

In the instant case, invention [I] has separate utility such as a transformer not ... using the shielding device of [IV], ... invention [IV] has separate utility such as a shielding device not use[d] in the transformer of [I], ... invention [II] has separate utility such as a power supply not using the transformer of [I], ... invention [III] has separate utility such as an electronic device not using the transformer of [I] or the power supply of [II] ... or using the shielding device of [IV], ... invention [V] has separate utility such as an electrical apparatus not using the transformer of [I] ... or using the shielding device of [IV]. (quoted verbatim, but rearranged to correspond with the discussion below). Office Action dated February 25, 2003.

Application Owner respectfully disagrees with the Examiner's statement.

Allowed claim 38 of Examiner's Group IV recites:

38. A shielding device for an electrical transformer having a first core portion and a second core portion,  
first and second windings on said first and second core portions respectively,  
said shielding device being constructed and arranged to electrically shield said first core portion from said second core portion. (emphasis added)

No separate utility, other than for use in a transformer having a first core portion and a second core portion, is claimed for the shielding device.

Claim 1, from which all the other claims of Group I depend, recites:

1. An electrical transformer for converting a first voltage to a second voltage, comprising:  
a core comprising a first core portion and a second core portion; and  
a first shielding device constructed and arranged to electrically shield said first core portion and a second core portion.

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 7 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

No separate utility, other than with a shielding device is claimed for the transformer.

Application Owner respectfully disagrees with the Examiner's statements in the Office Action mailed 2/25/2003 that:

"In the instant case, invention [I] has separate utility such as a transformer not ... using the shielding device of [IV]."

and

"[I]nvention [IV] has separate utility such as a shielding device not use[d] in the transformer of [I]."

In the restriction requirement, the Examiner notes that the examined and allowed claims 38-48 are drawn to a shielding device, classified in class 336, subclass 84R. While Application Owner agrees with this classification, Application Owner notes that the classification for class 336 is entitled "Inductor Devices" and subclass 84R is "with electric and/or magnetic shielding means." So class 336, subclass 84R is not directed to shielding devices generally; it is directed specifically to *Inductor Devices* with shielding means.

In the restriction requirement, the Examiner stated that Group I claims 1-13 are drawn to a transformer, classified in class 336, subclass 180. Class 336 is entitled "Inductor Device" and subclass 180 is entitled "Winding formed of plural coils (series or parallel)." Claim 1 does not recite plural coils; however claims 1 does recite a shielding device. Therefore, the claims of Group I are drawn to a transformer with a shielding device, which would be properly classified in Class 336, subclass 84R, the same class and subclass as Group IV.

The claims of Group II (claims 14-25) are drawn to a power supply. Claim 14, from which all the other claims of Group II depend, recites:

14. A power supply for an electronic device comprising:

...

a transformer having a core comprising a first core portion and a second core portion, and

a first shielding device constructed and arranged to electrically shield said first core portion from said second core portion.



Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 8 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

No separate utility is claimed for a power supply not comprising a transformer comprising a shielding device. Application Owner therefore respectfully disagrees with the Examiner's statement that "...invention [II] has separate utility such as a power supply not using the transformer of [I]."

The claims of Group III (claims 26-37) are drawn to an electronic device. Claim 26, from which all other claims of Group III depend, recites:

26. An electronic device, comprising:

...

a switching power supply ...

said switching power supply comprising a transformer having a first core portion, a second core portion, a first winding on said first core portion, and a second winding on said second core portion,

and a first shielding device constructed and arranged to electrically shield said first core portion from said second core portion.

No separate utility is claimed for an electronic device not comprising a power supply comprising a transformer having a shielding device.

Application Owner respectfully disagrees with the Examiner's statement that "...invention [III] has separate utility such as an electronic device not using the transformer of [I] or the power supply of [II] ... or using the shielding device of [IV].

The claims of Group V (claims 49-54) are drawn to an electrical apparatus. Claim 49, from which all the claims of Group V depend, recites:

49. Electrical apparatus comprising:

...

a transformer ...

said transformer having a core with first core and second core portions,

and a shielding device between said first and second core portions constructed and arranged to electrically shield said first core portion from said second core portion.

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 9 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

No separate utility is claimed for an electrical apparatus not comprising a transformer having a shielding device.

Application Owner respectfully disagrees with the Examiner's statement that "...invention [V] has separate utility such as an electrical apparatus not using the transformer of [I] ... or using the shielding device of [IV]."

The independent claims of Groups I, II, III, and V all recite limitations that are recited in the allowable claims in Group IV. Manifestly, the Examiner searched prior art for the presence of these limitations in the allowable claims in Group IV and were effectively searched without serious burden necessary for evaluating the patentability of claims 1-13, 14-25, 26-37 and 49-54 having these limitations.

In view of the foregoing reasoning and authorities, the Petition for Review and Withdrawal of the Requirement for Restriction should be granted and claims 1-13, 14-25, 26-37 and 49-54 examined on their merits. In the absence of more pertinent prior art, it is submitted that these claims are in a condition for allowance, and examination of these claims on their merits assisted by the search in connection with examining claims 38-48 should result in issuance of a Notice of Allowance.

Applicant : Wenjian Gu et al.  
Serial No. : 09/928,775  
Filed : August 13, 2001  
Page : 10 of 10

Attorney's Docket No.: 02103-415001 / AABOSS39

Please apply any other charges or credits to deposit account 06-1050, Order No. 02103-415001.

Respectfully submitted,

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